

**REMARKS**

Claims 1-35 are pending in the above-identified application. Claims 1-35 were rejected. With this Amendment, claims 1, 7, 8, 10, 11, 17, 18, 25, 26, and 31 were amended, claims 36-38 were added and claims 29, 30, 34, and 35 were cancelled. Accordingly, claims 1-28, 21-33, and 36-38 are at issue in the above-identified application.

**35 U.S.C. § 102 Anticipation Rejection of Claims**

Claims 1-5, 7-15, 17-19, 25-28, 30-33, and 35 were rejected under 35 U.S.C. § 102(b) as being anticipated by Oracle Forms ® Advanced Techniques ("Oracle"), Ch. 10, pgs. 1-18, © 1996 Oracle Corporation . Applicants respectfully traverse this rejection.

Applicant respectfully submits that Oracle does not disclose "automatically determining whether the first program is an unavailable program," as required by claims 1, 7, 8, 10, 11, 17, 18 and 25. Oracle teaches that when an application that originated an OLE object is not available, it may be possible to convert the OLE object to another format. To do so, Oracle states that the user must "move the cursor on the OLE container" (see pg. 17, step 1) and then "use the right mouse button to access the OLE popup menu" (see pg. 18, step 2) to choose the Convert option (see pg. 18, step 2). Thus, Oracle requires that the user manually choose and object and then initiate the conversion program.

By contrast, amended claims 1, 7, 8, 10, 11, 17, 18 and 25 require, among other limitations, "automatically determining whether the first program is an unavailable program." Thus, unlike in the cited art, the present invention does not require the user themselves to manually determine whether the first program is unavailable and that conversion to a different

format is required. Accordingly, applicant submits that claims 1, 7, 8, 10, 11, 17, 18 and 25 are in condition for allowance.

Applicant also respectfully submits that the Oracle does not disclose "while the document is being loaded, determining whether the first program is unavailable" and "when it is determined that the program is unavailable, converting the embedded object into a second format," as required by claims 9 and 19. As discussed above, Oracle teaches only that after a program is loaded, a user may manually choose to initiate conversion of an embedded object from one format to another. Oracle does not teach or even suggest determining whether the first program while the document is being loaded, nor does it teach or suggest that the embedded object may be converted into a second format while the document is being loaded. Accordingly, Applicant submits that claims 9 and 19 are allowable over the cited art.

### **35 U.S.C. § 103 Obviousness Rejection of Claims**

Claims 20 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Oracle Forms ® Advanced Techniques ("Oracle"), Ch. 10, pgs. 1-18, © 1996 Oracle Corporation, in view of *Francis et al.* (U.S. Patent No. 6,182,092). Claims 22-24, 29, and 34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Oracle Forms ® Advanced Techniques ("Oracle"), Ch. 10, pgs. 1-18, © 1996 Oracle Corporation. Applicants respectfully traverse these rejections.

First, Applicant submits that the cited art does not disclose "a second identifier of an available program to be used for accessing the embedded data when the original program becomes unavailable in the system," as required by claim 20. In the office action, the Examiner admits that Oracle does not teach the use of a first or second identifier. The Examiner then contends that *Francis* purportedly teaches the use of identifiers. However, while *Francis*

discloses that identifiers may be used to identify embedded object in a document and thus identify the program used to create the embedded object, *Francis* does not teach or even suggest that an embedded object may include a second identifier to identify a program to be used for accessing the embedded data when the original program is not available. Accordingly, applicant submits that independent claim 20 is allowable over the cited art.

Second, Applicant also submits that the prior art does not disclose the limitations of claims 26 and 31, as amended. Claims 26 and 31 require "receiving an indication of a different format suitable for use with a different program" and "converting the embedded data into a different format," both "while the document is being loaded into memory." As already discussed above, Oracle merely teaches that a user may manually choose to convert an embedded object after the object is already loaded. Oracle does not, however, teach or suggest that an indication of a different format may be received, and the conversion performed, while the program is being loaded. Accordingly, Applicant submits that claims 26 and 31 are in condition for allowance.

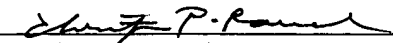
\* \* \*

Finally, Applicant has also added new claims 36, 37, and 38. Each of these claims requires "selecting a user selectable setting comprising at least a first setting for performing the step of converting while the document is being loaded into memory and a second setting for performing the step of converting upon selection of the document for editing." As discussed above, the cited art teaches that the format of an embedded object may be converted only by manually initiating the conversion. The cited art does not teach the user can select when to perform the conversion - i.e. during loading or upon selecting the document for editing. Accordingly, Applicant submits that new claims 36, 37, and 38 are also allowable.

In view of the foregoing, Applicants submit that the application is in condition for allowance. Notice to that effect is requested.

Respectfully submitted,

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